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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,189	09/13/2000	Hannes Eberle	53470.000038	8016

29315 7590 02/04/2004

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
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SUITE 900
RESTON, VA 20190

EXAMINER

NOLAN, DANIEL A

ART UNIT	PAPER NUMBER
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2654

22

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,189

Applicant(s)

EBERLE ET AL.

Examiner

Daniel A. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 21.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. The amendment filed 11 August 2003 was entered to the effect that the claims were changed as indicated and subsequently examined on the merits.

Response to Arguments

3. Applicant's arguments filed 11 August 2003 have been fully considered but they are not persuasive.
 - In response to applicant's argument that Logan et al establishes a session to notify of optimal times to schedule the commencement of a server session rather than to instantly *commence a voice service session*, the effect is that the *voice server session is commenced* with that activity. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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- Regarding the argument that Perrone does not disclose initiating communication, the citation of the prior art by the applicant in argument discloses that the capability is alternatively provided by telephony programs in the server (column 16 line 23).

With Perrone, the Voice control method of remote server involves associating server resource identifiers with voice command that in turn is associated with communication.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 11 August 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Logan et al, Perrone & Emnet et al

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (U.S. Patent 5,721,827) in view of Perrone (U.S. Patent 6,157,705) and further in view of Emnet et al ("Synthetic News Radio", IBM Systems Journal, Vol. 39, Nos. 3 & 4, April 2000, pages 646-659).

7. Regarding claims 1 and 11, Logan et al reads on the features, as:

- *Sensing a voice input command from the subscriber (Abstract, 18th line).*
- *Selecting at least one of a plurality of voice messages to deliver (Abstract, 21st line).*
- *A Content Delivery Module communicating with the Input Module to select messages to deliver to the subscriber (column 1 lines 39-42) according to command (the "express request" of column 1 line 47).*

While Logan et al might appear to "teach against" *initiating communication with subscribers*, he discloses the capability and describes precisely such an operation on a regular basis to notify of certain conditions (column 22 lines 60-63). Further, while it would appear to be obvious that this would be advantageous operation, Logan et al does not mention that this command dialog would occur *during the voice service session*.

Further prior art of reference is provided with the *voice control of a server* from Perrone disclosing such an operation as the normal operation in an operational example (Abstract, lines 10-end), reading on the feature of *a call server initiating* (1st two lines column 13) *an outbound communication* (column 15 lines 37-43) *to a voice service subscriber to commence a voice service session*.

- Perrone further discloses that the voice input command would occur *during the voice service session* (depicted by the uninterrupted voice communication session of figure 4, repeated in the last line of column 16).
- It would be obvious to a person of ordinary skill in the art of speech signal processing at the time of the invention to apply the method/teachings of Perrone to the device/method of Logan et al so as to permit operation without unwieldy input and output keys and screens.

Neither Logan et al nor Perrone disclose the additional feature that initiating communication is *based on the occurrence of a predetermined event specified by the subscriber during a subscription process*. Emnet et al further reads on the feature addressed by Perrone of *a call server initiating an outbound communication to a voice service subscriber to commence a voice service session* (lines 11-17 of the right column on page 658) and the feature not addressed of *initiating an outbound connection to a voice service subscriber* (last paragraph of the left column on page 658 to the 2nd paragraph of the right column) *to commence a voice service session based on the occurrence of a predetermined event specified by the subscriber during a subscription*

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process (by indicating interest or disinterest in the 2nd paragraph of the left column on page 658).

It would have been obvious to a person of ordinary skill in the art of speech signal processing at the time of the invention to apply the method/teachings of Emnet et al to the device/method of Logan et al and/or Perrone so as to automatically carry out schedule as established, operating independently in the manner of an alarm clock or appliance timer.

8. Regarding claims 2 and 12; the claims are set forth with the same limits as claims 1 and 11, respectively. Logan et al discloses that the sound card contains an *A/D converter* (column 3 line 24).

9. Regarding claims 3 and 13; the claims are set forth with the same limits as claims 1 and 12, respectively. Logan et al discloses that the sound card contains an *A/D converter* (column 4 line 22).

10. Regarding claims 4 and 14; the claims are set forth with the same limits as claims 2 and 13, respectively. Logan et al discloses the feature of *a communicating with the input module and the content delivery module and identifying the digital voice data as at least one of a plurality of predetermined commands* (as in column 32 line 27).

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11. Regarding claims 5 and 15; the claims are set forth with the same limits as claims 4 and 14, respectively. Logan et al discloses the feature of *presenting voice message content according to the digital voice data* (as in column 10 line 48).

12. Regarding claims 6 and 16; the claims are set forth with the same limits as claims 5 and 15, respectively. Logan et al discloses the feature of *at least one voice command prompt to query voice input from the subscriber* (as in column 12 line 50).

13. Regarding claims 7 and 17; the claims are set forth with the same limits as claims 6 and 16, respectively. Logan et al (column 15 line 21) discloses the feature of a *sequence of voice command prompts*.

14. Regarding claims 8 and 18; the claims are set forth with the same limits as claims 7 and 17, respectively. Logan et al (in the Abstract) discloses the feature of a *set of voice command prompts adaptively presented according to the digital voice data* (in lines (lines 6-16)).

15. Regarding claims 9 and 19; the claims are set forth with the same limits as claims 1 and 11, respectively. Logan et al (column 10 line 9) reads on the feature of *authenticating the subscriber for receipt of the at least one of a plurality of voice messages* (Abstract, line 21).

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16. Regarding claims 10 and 20; the claims are set forth with the same limits as claims 9 and 19, respectively. Logan et al (column 10 line 13) reads on the feature that *the authentication comprises at least one of PIN verification and voice identification*.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ball et al (U.S. Patent 6,240,391 B1) assembling and presenting structured voicemail messages.
- Cooper et al (U.S. Patent 6,466,654 B1) this *personal virtual assistant with semantic tagging* reads on the feature of *initiating an outbound connection to a voice server* (using *scripts* described in column 8 lines 7-11 as provided for in the *abstract*, lines 6-7) *based on the occurrence of a predetermined event specified by the subscriber during a subscription process* (by the *application creation process* during *registration*, column 27 lines 63 and column 28 line 60 to column 29 line 5), as when the scheduled event might involve paging on schedule (386-392 figure 32, 418 figure 35 and column 9 line 19).

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Daniel A. Nolan at telephone (703) 305-1368 whose normal business hours are Mon, Tue, Thu & Fri, from 7 AM to 5 PM.

If attempts to contact the examiner by telephone are unsuccessful, supervisor Richemond Dorvil can be reached at (703)305-9645.

The fax phone number for Technology Center 2600 is (703)872-9314. Label informal and draft communications as "DRAFT" or "PROPOSED", & designate formal communications as "EXPEDITED PROCEDURE". Formal response to this action may be faxed according to the above instructions,

or mailed to: Mail Stop AF (or CPA, etc. – see Official Gazette, 04 November 2003)
 P.O. Box 1450
 Alexandria, VA 22313-1450

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or hand-deliver to: Crystal Park 2,
2121 Crystal Drive, Arlington, VA,
Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office at telephone number (703) 306-0377.

Daniel A. Nolan
Examiner
Art Unit 2654

DAN/d
January 29, 2004


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER